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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/186,064	11/04/1998	THOMAS N. TOOMBS	HARI.127US0	1357

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EXAMINER

MYERS, PAUL R

ART UNIT	PAPER NUMBER
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2189

DATE MAILED: 10/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/186,064

Applicant(s)

TOOMBS ET AL.

Examiner

Paul R. Myers

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 87-103 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 87-103 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 August 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 87-103 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 87-90 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the protocols being selected due to multiple signals at reset and not solely the reset (See figure 9 and Page 6 line 28 to Page 7 line 18), does not reasonably provide enablement for solely the reset signal.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 88-90 recites the limitation "said initial reset command" Claim 87 upon which this claim depends has the language "initial reset signal". There is insufficient antecedent basis for said initial reset command the claim. The examiner notes to change the language of claim 87 to be initial reset command would alleviate both the 112-1st rejection of claim 87 and the 112-2nd rejection of claim 88 in that the reset command would be taken as not just the reset signal but also the state of the other signals provided at reset. For further examining purposes the examiner will interpret the reset signal as a reset command

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

7. Claims 87-88, 91-93, 97 are rejected under 35 U.S.C. 102(e) as being anticipated by Estakhri et al PN 6,181,162.

In regards to claims 87, 91-92 and 97: Estakhri et al teaches a memory card connectable to a master operating in a first protocol (either the PCMCIA mode 220 or the USB mode 250 or the ATA IDE mode 260) comprising: an interface for connection to the master (via the interface device) for the transfer of data and commands between the host and the memory card; a memory section for storing said data (inherent); and an interface controller (the part of the card that selects protocol) connected to the memory section and the interface, wherein the interface controller selects said first communication protocol from a plurality of protocols (PCMCIA, USB or ATA IDE) based on the initial reset signal received from the master (figure 3)

In regards to claims 88 and 93: Estakhri et al teaches the initial reset command including first connection pins that in the first protocol are not asserted and in the other protocol are asserted (Signals IOW*, IOR*, HCS0*, and HSC1*).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 89-90, 94-96, 98-101 are rejected under 35 U.S.C. 103(a) as being unpatentable over Estakhri et al PN 6,182,162.

In regards to claims 89-90, 94-95, 98-101: Estakhri et al teaches a plurality of protocols. Estakhri et al does not teach which specific protocols are supported. Official notice is taken that both the MultiMediaCard protocol and the Serial Peripheral Interface protocols are well known standard protocols. It would have been obvious to a person of ordinary skill in the art at the time of the invention to support these protocols because this would have made Estakhri et al's card compliant to both these standards.

In regards to claim 96: Estakhri et al only teaches one card. Official notice is taken that systems with multiple cards are well known such as for example the HP 48 SX calculator the examiner had in college which had two memory card slots. It would have been obvious to a person of ordinary skill in the art at the time of the invention to support multiple cards because this would have allowed for greater memory.

In regards to claims 102-103: Estakhri et al does not teach placing the memory card in another host. Estakhri et al does teach the method claimed of determining the communication protocol. Official notice is taken that using memory cards to transfer data from one host to another such as for example from a digital camera to a personal computer is well known in the

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art. It would have been obvious to couple Estakhri et al's memory card to another host because this would have allowed for the transferring of data.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The examiner must expressly note PN 6,038,400 to Bell et al that clearly teaches the claimed method of protocol selection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul R. Myers whose telephone number is 703 305 9656. The examiner can normally be reached on Mon-Thur 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Wong can be reached on 703 305 3477. The fax phone numbers for the organization where this application or proceeding is assigned are 703 746 7239 for regular communications and 703 746 7239 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305 3900.

PRM
October 29, 2002



PAUL R. MYERS
PRIMARY EXAMINER